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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/260,802	03/02/1999	STEVEN M. HOFFBERG	3459-11	6940

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EXAMINER

GORDON, PAUL P

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/260,802

Applicant(s)

Hoffberg et al.

Examiner

Gordon

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) 1-34 and 66-114 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

1. The drawings filed March 2, 1999 are objected to as the enclosed PTO-948 indicates.
2. This application contains claims 1-34, 66-112 drawn to an invention non-elected with traverse in Paper No. 7. A complete response to this final restriction requirement must include cancellation of nonelected claims or other appropriate action (37 C.F.R. §1.144) MPEP §821.01.

The requirement is still deemed proper and is therefore made FINAL.

3. Newly submitted claims 113 and 114 are directed to an invention that is independent or distinct from the invention elected in Paper No. 7 for the following reasons:

New claims 113 and 114 are not within the same class of technology as the group elected for examination by applicant because they claim a system and method for an electronic programming guide via a computer. Accordingly, claims 113 and 114 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. §1.142(b) and MPEP §821.03.

4. The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 35-65 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not describe or support the following claim language:

Claims 35 and 40:

- presenting the user related content records;
- receiving user feedback on said related content records;
- updating user feedback based on user feedback;

Claims 36, 41, 47 and 55:

- automatically presenting user's items of interest;
- a storing means comprising a computer system;
- a relating means comprising means for ranking a likely degree of interest;
- presenting it items in order of ranking;

Claims 37 :

- ranking user information on the basis of at least attribute;

Claim 38:

- the attribute is the contents of the item of information;

Claim 39:

the ranking means producing a formula for predicting an item on the basis of a user profile an item attribute;

Claim 43:

the user profiles and degree of interest are based upon one attribute of each item;

Claims 48 and 56;

a target server system;

at least one target profile summary being indicative of target objects and sets of target object characteristics;

storing user target profile interest summary;

Claim 51:

creating content profiles;

content profiles indicating the degree of content of said predetermined characteristics;

creating a customer profile for each eligible recipient;

Claims 52 and 60:

content profiles indicating the degree of content of said predetermined characteristics in each video program;

automatically updating customer's actual preferences for said predetermined characteristics;

Claim 54:

updating customer profiles to reflect the frequency of selection of the
data sources;

Claim 57:

means for correlating;

means for transmitting;

transmitting data...from said target server via a data communications
connections;

Claims 59 and 64:

content profiles indicating the degree of content of said predetermined
characteristics in each data source;

6. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 36, 40, 41, 48-52, 54-60, 63, and 64 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ In claim 36, line 10, the phrase, "the likely degree of interest", lacks proper antecedent basis; note on line 12, "aid", should read as --said--.

✓ In claim 40, last line, it is indefinite whether the claim is complete because it ends with a semi-colon.

✓ In claim 41, line 9, the phrase, "the user's likely degree of interest", lacks antecedent basis.

✓ In claim 48, line 3, the phrase, "said users", is unclear because no plural users were set forth previously in the claim language.

✓ In claims 49 and 57, lines 4 and 14, respectively, a ".", divides the claim causing the remainder of the claim to be indefinite.

✓ In claim 50, lines 2-3, the phrase, "the respective customer's preferences", lacks antecedent basis.

✓ In claim 51, line 4, the phrases, "the degree of content" and "said predetermined characteristics"; line 7, the phrase, "said customer profile creating step"; line 8, the phrase, "the customer's preferences"; line 10, the phrase, "said monitoring step"; line 12, the phrase, "said updating step", all lack antecedent basis.

✓ In claim 52, line 4, the phrase, "the degree of content"; lines 4-5, the phrase, "said predetermined characteristics"; line 7, the phrase, "said customer profile creating step"; lines 8-9, the phrase, "the customer's preferences"; line 10, the phrase, "said monitoring step"; line 12, the phrase, "said updating step", all lack antecedent basis.

✓ In claim 54, line 3, the phrase, "said customer profile creating step"; lines 4-5, the phrase, "the customer's preferences"; line 6, the phrase, "said monitoring step"; line 8, the phrase, "said updating step"; lines 8-9, the phrase, "the frequency of selection", all lack antecedent basis.

✓ In claim 56, line 3, the phrase, "said users", is unclear because no plural users were set forth previously in the claim language.

✓ In claims 55-57, are considered indefinite because an apparatus can not further limit a method the apparatus is not particularly defined.

✓ In claim 58, line 2, the phrase, "the respective customer's preferences"; lines 5-6, the phrase, "the content profiles", both lack antecedent basis.

✓ In claim 59, lines 3-4, the phrase, "the degree of content"; line 4, the phrase, "said predetermined characteristics", both lack antecedent basis.

In claim 60, line 4, the phrases, "the degree of content" and "said predetermined characteristics", both lack antecedent basis.

✓ In claim 63, line 8, the phrase, "the frequency of selection", lacks antecedent basis.

✓ In claim 64, line 6, the phrase, "the degree of content", lacks antecedent basis.

Claims 37-39, 42-46, 53, 61, 62, and 65 also stand rejected based on their dependency of rejected base claims and/or intermediary claims above.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 35, 40, 47, 55, 58 are rejected under 35 U.S.C. §102(b) as being anticipated by Yourick et al. (4,775,935).

Yourick et al. (hereinafter "Yourick") anticipate a system and method which store item records and present related items to user's who selectively access and query interesting items (col. 4, lines 65-66; interface 7). The selected items of interest are stored as a consumer profile uniquely and historically related to each and every user of the system (see col. 5, Tables 1-3; col. 4, lines 64-68; col. 8, lines 60-62). Items presented (col. 8, lines 63-64) to the users are monitored by the system and based upon the user's interest or feedback (Table 1) a consumer profile is created and stored. The user feedback is monitored and used to update the consumer profile and related records in storage.

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 36-39, 48, 50-52, 54, 56, 59-61, and 63 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yourick et al. (4,775,935).

The 35 U.S.C. §102(b) rejection above is incorporated herein by reference.

With regard to claims 36-39, 48, 50, and 56, Yourick teaches a system and method for automatically presenting information items of interest to users. The system includes a

computer and memory for storing the item records and an access or terminal device for enabling users to communicate and access the stored items. User selections and/or interests are monitored, stored, and updated on the basis of feedback received from the user. Yourick does not teach ranking the likely degree of interest a user has in particular item(s). However, a score or trend in the user's feedback or interest is deduced and later used to predict which items should be presented to the user in a sorted order. Table 8 illustrates the user's interest in ascending order. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to rank the degree of a user's interest in an item because Yourick's trend prediction is a direct indication of the degree of interest a user has while previewing the presented items.

With regard to claims 51, 52, 59, and 60 Yourick teaches a system and method for automatically presenting created content profiles or video programs for each item of interest to users. Customer profiles are created based on user preferences and interests. The profiles are monitored and automatically updated based on customer preference of items. Yourick do not teach indicating the degree of content in each content profile(data source). Yourick does teach that the items of interest are patterns which are relative to the item profile. Further, these patterns are updated and stored as an item's consumer attributed information. When the user requests to view items having certain attributes the system retrieves related or similar items of interest from memory. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to indicate the degree of content of an item profile because the user is permitted to view items sharing the same attributes or degree of likenesses.

With regard to claims 54 and 63, Yourick does not teach updating customer profiles to reflect the frequency of selection of the content profiles. Yet, Yourick does reorder or score the profiles in an order of user interest as depicted in table 8 and column 8, lines 59+. Also, in column 4, lines 10-11, Yourick teaches recording the frequency of inspection of an item to recognize a user's interest. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to reflect the frequency of selection of content profiles because Yourick ranks the profiles viewed by users according to their likely predicted interest in the item inspected by the user.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103[®] and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

13. Claims 35-39, 40-46, and 47-65 of this application have been copied by the applicant from U. S. Patent No(s). 5,724,567, 5,758,257, and 5,754,939, respectively. These claims are not patentable to the applicant because of the 35 U.S.C. §112, 1st & 2nd paragraph; the 35 U.S.C. §102(b); and the 35 U.S.C. §103 rejections above.

An interference cannot be initiated since a prerequisite for interference under 37 C.F.R. § 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Gordon whose telephone number is (703) 305-9760. The examiner can normally be reached on Mondays through Thursdays from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black, can be reached on (703) 305-9707. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


PAUL P. GORDON
PRIMARY EXAMINER

ppg
March 19, 2002